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REMARKS

Applicant hereby makes a request for continued examination under the provisions of 37 CFR §1.114. Reconsideration of the rejections set forth in the Office action dated 3/24/04 is respectfully requested

Included herewith is a petition for a one month extension of time and authorization to pay the fee from Deposit Account 24-0025.

Claims 1-8 are pending.

Claims 1-8 stand rejected.

Claims 1, 3, 5, and 7 have been amended. These claims were amended to clarify that information is extracted from the loaded document and that the loaded document is processed according to the processing rule and the extracted information to relate the loaded document with one or more of the other personal documents. These amendments are supported in the application at page 2, lines 5-10 and at page 8, lines 5-10, and step 218.

Note regarding the office action reply to the office action mailed 10/14/2003

Applicant would like to point out to the Examiner that the amendments made to claim 7 in the prior office action reply included an additional element and a renumbering of subsequent elements. In the prior office action reply Applicant indicated the deletion of an element number by the use of a single pair of brackets (for example [2]) instead of a double pair of brackets (for example [[2]]). Applicant apologies for any confusion this may have caused. The current listing of claims makes the assumption that these amendments were effective in the prior office action.

35 USC § 102(b)

Claims 1, 3, and 5 under 35 U.S.C. § 102(b) as being anticipated by Unger (US 5,721,910). Anticipation under 35 U.S.C. § 102 requires that each and every claim limitation be disclosed by the applied reference. In fact, as stated in MPEP 2131, "[t]he identical invention must be shown in as complete detail as is contained in the ... claim,"

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citing *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). In the context of court review of a defense to infringement on the grounds that a patent was invalid due to lack of novelty under 35 U.S.C. § 102, the Federal Circuit has said, "[w]hen the defense of lack of novelty is based on a printed publication that is asserted to describe the same invention, a finding of anticipation requires that the publication describe all of the elements of the claims, arranged as in the patented device." *C.R. Bard, Inc. v. M3 Systems, Inc.*, 157 F.3d 1340, 1349, 48 USPQ2d 1225, 1229-30 (Fed. Cir. 1998). Applying that standard to the subject application, to make a prima facie case of anticipation, the Examiner must show that the Unger reference describes all of the elements of claims 1, 3, 5 and 7, arranged as in those claims. As the MPEP further notes, "[t]he elements must be arranged as required by the claim, but this is not an ipsissimis verbis test, i.e., identity of terminology is not required," citing *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

It is respectfully submitted that the Unger reference does not teach each and every claim limitation of currently amended claims 1, 3, 5, and 7 as arranged in those claims, and therefore cannot anticipate these claims.

The claim limitations of the subject invention.

Independent, currently amended claim 1 is:

A computer-implemented method for managing a plurality of personal documents, comprising:
loading one of the plurality of personal documents into storage, said loaded document having a category;
determining the document category;
extracting information from said loaded document;
receiving at least one processing rule, wherein the rule is associated with the document category, and wherein said processing rule embodies information-flow-knowledge between said loaded document and other of said plurality of personal documents; and
processing said loaded document according to the processing rule and said extracted information to relate said loaded document with one or more of said other of said plurality of personal documents.

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The instant invention addresses the problem of storing and managing personal documents. In particular, the invention addresses the problem of relating different types of personal documents together (page 1, lines 16-22).

In currently amended claim 1, the "document category" relates to the function of the document (see page 5 lines 2-9 that provides example categories such as bills, invoices, receipts, bank and brokerage statements, tax returns, product warranties and checks). The determination of the document category can be accomplished by evaluating characteristics of the document including such characteristics as the shape of the document, particular types of data on the document (such as account number or logo), pattern or format of the document (page 5, line 10 – page 6, line 4). Thus, for example, the document can be categorized as a bill, an invoice, a receipt, a bank statement, a brokerage statement, a tax return, a product warranty, or a check (page 5, lines 3-6).

When the document is categorized and information extracted from it, the document is processed using the processing rule for the document category and the extracted information to relate the loaded document with one or more of the other personal documents. The processing rule embodies information-flow-knowledge between the loaded document and other personal documents (page 2, lines 5-7; page 6, line 16-18; and page 8, lines 5-6). For example, aspects of the invention could associate credit card receipts with credit card bills and the checks used to pay these bills.

Independent currently amended claim 3, directed to a computer system, independent currently amended claim 5, directed to a computer program, and independent currently amended claim 7, directed to a downloaded computer program, have limitations and meaning similar to claim 1. Thus, the discussion below, while referring to independent claim 1, applies equally to claims 3, 5, and 7.

Discussion of the teachings of the Unger reference.

The Unger reference discloses a multi-dimensional database that models a business or scientific or technical body of work (Column 1, lines 8-11). Unger addresses the problem of identifying unanticipated trends and discontinuities in the pattern of

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research effort in a technical, scientific, or business entity or discipline as reflected by the technical documents and/or patents obtained by the entity.

Unger's invention analyzes the technical information contained within a document (such as a patent) and then classifies this technical information. Unger analyzes the technical content of each patent or technical document with respect to a pre-defined model of the scientific or business discipline (Column 4, lines 32-44; Column 6, lines 60-67) "to identify and categorize documents to fit a pre-defined matrix of technical categories" (Column 7, lines 1-5). The categorization can then be used to identify trends and discontinuities in the research efforts represented by the technology in the underlying technical documents.

Detailed Analysis of the differences between the claimed invention and the teachings of Unger.

The Office Action asserts Unger teaches the element of "loading one of the plurality of personal documents into storage, said loaded document having a category" citing Unger Col.2, lines 58-65. Unger's documents are not personal documents, but instead are technical documents such as patents and technical documents (U: Column 3, lines 8-12). Examples of the personal documents of the instant invention are bills, checks, receipts, etc. (page 5, lines 3-6).

The Office Action also asserts that Unger column 3, lines 22-28; column 4 lines 44-57 and column 7, lines 40-46 teach receiving at least one processing rule. The limitation in currently amended claim 1 is that of receiving a processing rule that is associated with the document category and embodies information-flow-knowledge between the loaded document and other of the personal documents. Unger column 3, lines 22-28 teaches that information in Unger's database can be accessed to identify research trends and discontinuities. This reference also teaches that technical experts can [d]rill-down and examine the underlying documents. This reference teaches nothing about a processing rule associated with a document category where the rule embodies information-flow-knowledge between one document and another.

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The Office Action also cites Unger column 4, lines 44-57 as teaching receiving at least one processing rule. The limitation in currently amended claim 1 is that of receiving a processing rule that is associated with the document category and embodies information-flow-knowledge between the loaded document and other of the personal documents. This cite teaches that scientists, when evaluating information from the technical documents that have the same classification, fill out subject-specific tables in the database of technical details disclosed in the technical documents. Thus, this citation teaches that scientists can extract information from technical documents that have the same classification and add the extracted information back into the database. This reference teaches nothing about a processing rule associated with a document category where the rule embodies information-flow-knowledge between one document and another.

In addition the Office Action cites Unger column 7, lines 40-46 as teaching receiving at least one processing rule. The limitation in currently amended claim 1 is that of receiving a processing rule that is associated with the document category and embodies information-flow-knowledge between the loaded document and other of the personal documents. This reference teaches nothing about a processing rule associated with a document category where the rule embodies information-flow-knowledge between one document and another.

The Office action also cited Unger column 4, lines 44-57, column 5, lines 17-35, and column 7, lines 40-46 as teaching that the processing rule embodies information flow knowledge between the loaded document and other of the personal documents. Applicant repeats previous discussions of the Unger column 4, lines 44-57 and column 7, lines 40-46 references and reiterates that these references teach nothing about a processing rule associated with a document category where the rule embodies information-flow-knowledge between one document and another.

With regard to Unger column 5, lines 17-36: This reference teaches electronic capture of technical documents and the extraction of information related to that document for inclusion in the database. While this citation mentions that the extracted information

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is linked to a particular patent family, there is no information-flow-knowledge between the linked documents.

The Office Action also referenced Unger column 3, lines 22-28, column 4, lines 44-57 and column 7, lines 40-46 to the limitation of processing. The currently amended limitation of processing is: "processing said loaded document according to the processing rule and said extracted information to relate said loaded document with one or more of said other of said plurality of personal documents". None of these references (already discussed) teach processing the loaded document according to a processing rule (that embodies information-flow-knowledge from the previous limitation) and the extracted information to relate the loaded document with other of the personal documents.

Thus, Unger does not teach each and every claim limitation of currently amended claims 1, 3, and 5, (the same arguments apply to claim 7) as arranged in those claims and applicant must respectfully traverse this objection to these claims.

II. Rejections under 35 USC §103

Claim 7 stands rejected under 35 USC §103(a) as being unpatentable over Unger. Claim 7 has been amended to claim a downloaded computer program similar to the computer program product of claim 5.

Having addressed the differences between Unger and the instant application, applicant believes currently amended claims 1, 3, 5, and 7 are patentable because the Examiner would need to provide one or more references that were available to the inventor and that teach a suggestion to combine or modify the references, the combination or modification of which would appear to be sufficient to have made the claimed invention obvious to one of ordinary skill in the art.

Nothing in Unger suggests the problem addressed by the instant invention; that of storing and managing personal documents.

The problem addressed by Unger is that of analyzing technical content of documents such as patents and other scientific literature and of categorizing the information of these documents to identify trends and discontinuities in the overall

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patterns of research efforts reflected by the technical content of these documents (U: Col 1, line 17 – Col 2, line 10).

Unger does not teach or suggest the use of personal documents (such as bills, invoices etc. see page 5, lines 3-6), processing rules that embody information-flow-knowledge between documents (page 8, lines 5-6) or processing the personal document according to the processing rule using information extracted from the personal document and the information-flow-knowledge to relate the document to one or more of the other personal documents. Thus, claims 1, 3, 5 and 7 are patentable over Unger.

Claims 2, 4, 6, and 8 are rejected under 35 USC 103(a) as being unpatentable over Unger in view of MacPhail.

Claims 2, 4, 6, and 8 are patentable over Unger in view of MacPhail because nothing in Unger or MacPhail, separately or combined would teach a suggestion that Unger's techniques would be applicable to personal documents, or teach a suggestion to include have rules that embody information flow between documents.

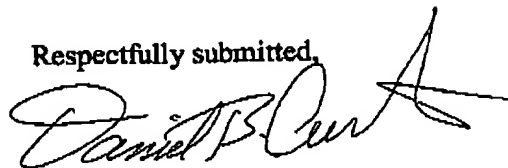
Claims 2, 4, 6 and 8 depend on and further limit claims 1, 3, 5, and 7 that are patentable and so are also patentable.

Since all rejections, objections and requirements contained in the outstanding official action have been fully answered or traversed and shown to be inapplicable to the present claims, it is respectfully submitted that reconsideration is now in order under the provisions of 37 CFR §1.111(b) and such reconsideration is respectfully requested. Upon reconsideration, it is also respectfully submitted that this application is in condition for allowance and such action is therefore respectfully requested.

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Should any additional issues remain, or if I can be of any additional assistance,
please do not hesitate to contact me at (650) 812-4259.

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Daniel B. Curtis", with a stylized flourish extending from the end.

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